

ESTTA Tracking number: **ESTTA458849**

Filing date: **02/28/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Casella Wines Pty Limited
Granted to Date of previous extension	02/29/2012
Address	1471 Wakley Road Yenda, NSW2681 AUSTRALIA
Attorney information	David M. Perry Blank Rome LLP 130 North 18th Street Philadelphia, PA 19103 UNITED STATES perry@blankrome.com Phone:215-569-5767

### Applicant Information

Application No	85345127	Publication date	11/01/2011
Opposition Filing Date	02/28/2012	Opposition Period Ends	02/29/2012
Applicant	Thomas, Kurtis Lee PO Box 6505 Providence, RI 02940 UNITED STATES		

### Goods/Services Affected by Opposition


Class 033. All goods and services in the class are opposed, namely: Vodka
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3578511	Application Date	06/22/2007
Registration Date	02/24/2009	Foreign Priority Date	NONE
Word Mark	YELLOW TAIL		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 2001/06/00 First Use In Commerce: 2001/06/00 Wine

U.S. Registration No.	2696372	Application Date	12/12/2000
Registration Date	03/11/2003	Foreign Priority Date	NONE
Word Mark	[YELLOW TAIL]		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2001/06/01 First Use In Commerce: 2001/06/01 Wine		

Attachments	77212872#TMSN.jpeg ( 1 page )( bytes ) 76179270#TMSN.gif ( 1 page )( bytes ) PINKTAIL VODKA Notice of Opp.pdf ( 19 pages )(5624048 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/David M. Perry/
Name	David M. Perry
Date	02/28/2012



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Casella Wines Pty Ltd.,  
an Australian corporation,

Opposer,

v.

Kurtis Lee Thomas d/b/a BrainyActs,  
an individual,

Applicant.

Serial No.: 85/345,127

Opposition No.: \_\_\_\_\_

Hon. Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Attn.: Trademark Trial and Appeal Board

Madam:

Pursuant to Federal Rule of Civil Procedure 15(a) and 37 C.F.R. § 2.101 et seq., Opposer respectfully requests that the Board accept the enclosed Notice of Opposition against the mark PINKTAIL VODKA. We respectfully request that this Notice of Opposition be instituted and that, in due course, notification be sent regarding answer dates and testimony periods. Please charge our Deposit Account No. 02-2555 for fees due in connection with the filing of this Notice of Opposition.

Respectfully submitted,

CASELLA WINES PTY LTD.

Date: February 28, 2012

By:



Alfred W. Zaher  
David M. Perry  
Jamie L. Bertha  
Its Attorneys

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of Kurtis Lee Thomas d/b/a BrainyActs

Application No.: 85/345,127

Filed: June 13, 2011

Mark: PINKTAIL VODKA

Casella Wines Pty Ltd.,	:	
an Australian corporation,	:	
	:	
Opposer,	:	Serial No.: 85/345,127
	:	
v.	:	Opposition No.: _____
	:	
Kurtis Lee Thomas d/b/a BrainyActs,	:	
an individual,	:	
	:	
Applicant.	:	
	:	

Hon. Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Attn.: Trademark Trial and Appeal Board

**NOTICE OF OPPOSITION**

Madam:

Opposer, Casella Wines Pty Ltd., an Australian corporation located at 1471 Wakley Road, Yenda Australia NSW 2681, believes that it would be damaged by the registration of the mark shown in Application Serial No. 85/345,127 and hereby opposes the same under the provision of Section 13 of the Trademark Act of July 5, 1946, as amended, 15 U.S.C. § 1063.

As grounds of opposition, it is alleged that:

### **BACKGROUND ON OPPOSER'S MARKS**

1. Opposer has made continuous and extensive use of the following distinctive marks comprised in whole or in part of the words "YELLOW TAIL"; YELLOW TAIL; [YELLOW TAIL]; [YELLOW TAIL] (Stylized); and YELLOW TAIL and Design (collectively, hereinafter "the YELLOW TAIL Mark"), which use has developed widespread public recognition and appeal. Opposer has used the YELLOW TAIL Mark on or in connection with a variety of goods, including without limitation, wine and related merchandise (hereinafter, "the Goods").

2. Opposer is the exclusive owner of all rights, title and interest in and to the YELLOW TAIL Mark and is the owner of various U.S. applications and registrations for the same, including (among others):

YELLOW TAIL U.S. Registration No. 3,578,511; and

**[yellow tail]** U.S. Registration No. 2,696,372.

Opposer's registrations are valid and subsisting and are conclusive evidence of Opposer's exclusive right to use the YELLOW TAIL Mark in commerce for the Goods and for those goods within the zone of natural expansion.

3. Through extensive and continuous use, the YELLOW TAIL Mark has become famous and acquired substantial goodwill in connection with the Goods.

4. Opposer's extensive marketing, promotion and use of the YELLOW TAIL Mark in commerce since at least as early as June 1, 2001 has caused customers, prospective purchasers, and the general public to immediately associate the YELLOW TAIL Mark with Opposer, and to expect a wide variety of goods bearing the YELLOW TAIL Mark to have a connection with, or association with, Opposer.

**APPLICANT'S MARK IS LIKELY TO CAUSE CONFUSION  
AS TO SOURCE, ORIGIN, SPONSORSHIP, OR AFFILIATION**

5. Opposer repeats and realleges the allegations contained in paragraphs 1 through 4 above, as if fully set forth herein.

6. On June 13, 2011, Applicant filed application No. 85/345,127 for registration of the mark PINKTAIL VODKA (hereinafter "Applicant's Mark") for "vodka." Applicant's Mark was published for opposition in the Official Gazette of November 1, 2011 (printout attached).

7. Applicant's basis for filing is intent to use, pursuant to Section 1(b) of the Lanham Act.

8. Opposer's use of the YELLOW TAIL Mark predates Applicant's filing date.

9. Applicant's Mark PINKTAIL VODKA is confusingly similar to the YELLOW TAIL Mark owned by Opposer.

10. Applicant's Mark is inter alia comprised of a color followed by "TAIL".

11. The use and registration of Applicant's Mark to identify its goods is likely to cause confusion, mistake and deception as to the source, origin, sponsorship or association of the goods and will injure Opposer.

12. Any defects, objections or faults found with the goods sold and rendered by Applicant under Applicant's Mark, because of the false association with Opposer, would inflict serious injury upon the reputation of Opposer.

13. The grant of a Certificate of Registration to Applicant for Applicant's Mark would be inconsistent with, and in derogation of, Opposer's prior rights and would therefore cause damage and injury to Opposer and deception of, and confusion to, the public.

**APPLICANT'S MARK IS LIKELY TO DILUTE  
THE DISTINCTIVE QUALITY OF OPPOSER'S FAMOUS MARK**

14. Opposer repeats and realleges the allegations contained in paragraphs 1 through 13 above, as if fully set forth herein.

15. Prior to both Applicant's application to register Applicant's Mark and any use of Applicant's Mark by Applicant, Opposer's YELLOW TAIL Mark was distinctive and had become famous.

16. The fame and high degree of recognition afforded to Opposer's Mark is evident in the significant duration, extent and geographic reach of advertising and publicity bearing the mark; the widespread and extraordinary sales of the Goods bearing the YELLOW TAIL Mark; the widespread recognition of the YELLOW TAIL Mark among the general consuming public; and the registration of the YELLOW TAIL Mark on the Principal Register.

17. That Applicant's Mark is likely to cause dilution by blurring is evident in the high degree of similarity between Applicant's Mark and the YELLOW TAIL Mark; the high degree of inherent and acquired distinctiveness of the YELLOW TAIL Mark; the substantially exclusive use of the YELLOW TAIL Mark on the Goods; the extraordinary degree of recognition accorded to the YELLOW TAIL Mark by the general consuming public; the apparent intent of Applicant to create an association with the YELLOW TAIL Mark; and any actual association between Applicant's Mark and the YELLOW TAIL Mark that would be established during discovery.

18. The use and registration of Applicant's Mark to identify its goods, after the YELLOW TAIL Mark had become famous, is likely to cause dilution by blurring or dilution by tarnishment of the YELLOW TAIL Mark, regardless of the presence or absence of actual or likely confusion, or competition, and will injure Opposer and the public.



19. Any defects, objections or faults found with the goods sold by Applicant under Applicant's Mark, would inflict serious injury upon the reputation of Opposer.

20. The grant of a Certificate of Registration for Applicant's Mark would be inconsistent with, and in derogation of, Opposer's prior rights and would therefore cause damage and injury to Opposer and the public.

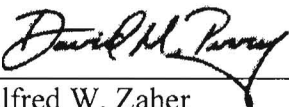
For the reasons set forth in the foregoing paragraphs, Opposer believes that it would be damaged by the registration of Applicant's Mark and, thus, Applicant should be denied registration of the mark.

WHEREFORE, Opposer prays that this opposition be sustained and that Application Serial No. 85/345,127 be refused registration.

Respectfully submitted,

CASELLA WINES PTY LTD.

Date: February 28, 2012

By:   
Alfred W. Zaher  
David M. Perry  
Jamie L. Bertha  
Its Attorneys

BLANK ROME LLP  
ONE LOGAN SQUARE  
PHILADELPHIA, PA 19103  
(215) 569-5767

CERTIFICATE OF ELECTRONIC FILING

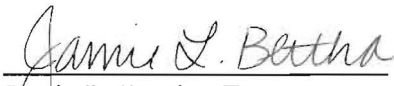
I hereby certify that this correspondence is addressed to the Trademark Trial and Appeal Board, Hon. Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, and is being deposited via the Electronic System for Trademark Trials and Appeals (ESTTA) on February 28, 2012.

  
Jamie L. Bertha, Esq.

CERTIFICATE OF SERVICE

I, Jamie L. Bertha, do hereby certify that I have on February 28, 2012, mailed via first class mail, the foregoing Notice of Opposition to the following:

Kurtis Lee Thomas  
P.O. Box 6505  
Providence, RI 02940

  
\_\_\_\_\_  
Jamie L. Bertha, Esq.

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2012-02-28 10:53:50 ET**

**Serial Number:** 77212872 Assignment Information Trademark Document Retrieval

**Registration Number:** 3578511

**Mark**

# YELLOW TAIL

**(words only):** YELLOW TAIL

**Standard Character claim:** Yes

**Current Status:** Registered. The registration date is used to determine when post-registration maintenance documents are due.

**Date of Status:** 2009-02-24

**Filing Date:** 2007-06-22

**Filed as TEAS Plus Application:** Yes

**Currently TEAS Plus Application:** Yes

**Transformed into a National Application:** No

**Registration Date:** 2009-02-24

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 112

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov**

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2009-02-24

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## LAST APPLICANT(S)/OWNER(S) OF RECORD

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1. Casella Wines Pty Ltd.

**Address:**

Casella Wines Pty Ltd.  
1471 Wakley Road  
Yenda NSW2681  
Australia

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Australia

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### GOODS AND/OR SERVICES

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**International Class:** 033

**Class Status:** Active

Wine

**Basis:** 1(a)

**First Use Date:** 2001-06-00

**First Use in Commerce Date:** 2001-06-00

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### ADDITIONAL INFORMATION

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**Prior Registration Number(s):**

2696372

2862612

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2009-02-24 - Registered - Principal Register

2009-01-21 - TTAB Release Case To Trademarks

2009-01-21 - Opposition terminated for Proceeding

2009-01-21 - Opposition dismissed for Proceeding

2008-03-06 - Opposition instituted for Proceeding

2007-11-07 - Extension Of Time To Oppose Received

2007-11-06 - Published for opposition

2007-10-17 - Notice of publication

2007-10-01 - Law Office Publication Review Completed

2007-09-26 - Approved for Pub - Principal Register (Initial exam)

2007-09-23 - Assigned To Examiner

2007-07-19 - Applicant amendment prior to exam entered

2007-07-19 - Assigned To LIE

2007-07-03 - TEAS Voluntary Amendment Received

2007-06-26 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

David M. Perry

**Correspondent**

DAVID M. PERRY

BLANK ROME LLP

ONE LOGAN SQUARE 9TH FLOOR

PHILADELPHIA, PA 19103-6998

Phone Number: (215) 569-5767

Fax Number: (215) 832-5767

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### Assignments on the Web > Trademark Query

**No assignment has been recorded at the USPTO**

**For Serial Number: 77212872**

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Web interface last modified: Jan 26, 2012 v.2.3.1

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**Serial Number:** 76179270 Assignment Information Trademark Document Retrieval

**Registration Number:** 2696372

**Mark**

**[yellow tail]**

**(words only):** [YELLOW TAIL]

**Standard Character claim:** No

**Current Status:** A Sections 8 and 15 combined declaration has been accepted and acknowledged.

**Date of Status:** 2008-09-12

**Filing Date:** 2000-12-12

**Transformed into a National Application:** No

**Registration Date:** 2003-03-11

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 108

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov**

**Current Location:** 40S -Scanning On Demand

**Date In Location:** 2011-06-23

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. Casella Wines Pty Ltd.

**Address:**

Casella Wines Pty Ltd.  
Farm 1471 Wakley Road  
YENDA NSW 2681  
Australia

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Australia

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**GOODS AND/OR SERVICES**

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**International Class:** 033

**Class Status:** Active

Wine

**Basis:** 1(a)

**First Use Date:** 2001-06-01

**First Use in Commerce Date:** 2001-06-01

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2011-06-23 - Case File In TICRS

2011-06-22 - Case File In TICRS

2008-09-12 - Section 8 (6-year) accepted & Section 15 acknowledged

2008-09-12 - Assigned To Paralegal

2008-09-11 - TEAS Section 8 & 15 Received

2006-08-18 - Attorney Revoked And/Or Appointed

2006-08-18 - TEAS Revoke/Appoint Attorney Received

2003-03-11 - Registered - Principal Register

2003-01-06 - Allowed for Registration - Principal Register (SOU accepted)

2002-12-30 - Assigned To Examiner

2002-12-10 - Statement Of Use Processing Complete

2002-10-24 - Use Amendment Filed

2002-10-25 - PAPER RECEIVED



2002-08-06 - NOA Mailed - SOU Required From Applicant

2002-04-02 - Published for opposition

2002-03-13 - Notice of publication

2001-09-24 - Approved For Pub - Principal Register

2001-05-29 - Communication received from applicant

2001-05-02 - Non-final action mailed

2001-04-18 - Assigned To Examiner

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Alfred W. Zaher

**Correspondent**

Alfred W. Zaher

Blank Rome LLP

9th Floor

One Logan Square

Philadelphia PA 19103-6998

Phone Number: 215-569-5364

Fax Number: 215-832-5364

**Domestic Representative**

Timothy D. Pecsénye, Alfred W. Zaher, Da

vid M. Perry, Emily J. Barnhart, Bruce D

. George, Lisa Casey Spaniel, Megan E. S

pitz, and Zachary A. Aria

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**Serial Number:** 85345127 Assignment Information Trademark Document Retrieval

**Registration Number:** (NOT AVAILABLE)

**Mark**

**PINKTAIL VODKA**

**(words only):** PINKTAIL VODKA

**Standard Character claim:** Yes

**Current Status:** A request for an extension of time to file an opposition has been filed with the Trademark Trial and Appeal Board. For further information, see TTABVUE on the Trademark Trial and Appeal Board web page.

**Date of Status:** 2011-11-01

**Filing Date:** 2011-06-13

**Transformed into a National Application:** No

**Registration Date:** (DATE NOT AVAILABLE)

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 115

**Attorney Assigned:**  
LOWRY LEIGH A

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2011-09-26

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. Thomas, Kurtis Lee

**DBA/AKA/TA/Formerly:** DBA BrainyActs

**Address:**

Thomas, Kurtis Lee  
PO Box 6505

Providence, RI 02940

United States

**Legal Entity Type:** Individual

**Country of Citizenship:** United States

**Phone Number:** 4016512626

**Fax Number:** 18007019904

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### GOODS AND/OR SERVICES

---

**International Class:** 033

**Class Status:** Active

Vodka

**Basis:** 1(b)

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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### ADDITIONAL INFORMATION

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**Disclaimer:** "VODKA"

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### MADRID PROTOCOL INFORMATION

---

(NOT AVAILABLE)

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### PROSECUTION HISTORY

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**NOTE:** To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2011-11-01 - Extension Of Time To Oppose Received

2011-11-01 - Official Gazette Publication Confirmation E-Mailed

2011-11-01 - Published for opposition

2011-09-24 - Approved For Pub - Principal Register

2011-09-24 - Assigned To Examiner

2011-06-17 - Notice Of Pseudo Mark Mailed

2011-06-16 - New Application Office Supplied Data Entered In Tram

2011-06-16 - New Application Entered In Tram

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### ATTORNEY/CORRESPONDENT INFORMATION

---

**Correspondent**

THOMAS, KURTIS LEE

PO BOX 6505

PROVIDENCE, RI 02940-6505

Phone Number: 4016512626

Fax Number: 18007019904

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Web interface last modified: Jan 26, 2012 v.2.3.1

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